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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,938	08/29/2001	Koichiro Kishima	SON-2217	5834

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,938

Applicant(s)

KISHIMA ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-18 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 29 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al patent number 4,662,717.

Yamada et al reads on these claims by disclosing the limitations therein including the following: an optical system (abstract, Figure 8) comprising first and second optical lenses arranged to have coinciding or substantially coinciding optical axes (Figure 8 re elements "10" and "20a"); the first optical lens has a convex portion serving as a convex lens and an outer circumference portion around the convex portion (Figure 8, lens "20a"); a thickness of the outer circumference portion is greater than a thickness at the convex portion (Figure 8, lens "20a" where the outer circumference portion "24" has a thickness greater than at the convex portion "21"); the outer circumference portion of the first optical lens and of the second optical lens are fixed in place relative to each other (Figure 8 with outer circumference portion "24" of lens "20A" being connected to outer circumference portion "12" of lens "10"); and a convex portion of the first optical lens faces the second lens (Figure 8 i.e. a convex portion of lens "20A" faces lens "10").

Yamada, discloses as is set forth above and the ball and joint fittings of Yamada (Figure

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8 and column 4, line 66 to column 5, line 10) can inherently be considered as "bonded" (with Webster's dictionary having a definition of "bonded" as being "fastened together"). Yamada et al further discloses a facing surface of the outer circumferential portion of the first and second surface as flat or approximately flat (Figure 8 with the portion above or below the knob "23" of both lens "20A" and "10" as flat); and the first optical lens further comprising a flat portion positioned around the convex portion and a thickness at the outer circumference greater than at the flat portion (Figure 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims and 5, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al.

In reference to these claims, Yamada et al discloses as is set forth above and further discloses: the claimed facing surfaces as vertical or substantially vertical (Figure 8, with the portion above and/or below the knob "23" of both lens "20A" and "10" as vertical); the claimed mounting surface of the first optical lens as flat (Figure 8, with the portion above and/or below the knob "23" of lens "20A" as flat); and a bottom surface of the outer circumference portion of the second optical lens as flat (Figure 8, with the bottom portion of lens "10" as flat or the surface where "12A" is pointing in Figure 8 as a flat bottom surface of lens "10"). Yamada discloses as is set forth above but does not

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specifically disclose the surfaces being bonded together "with an adhesive". However, Yamada discloses the surfaces as being attached together by joint fittings (Figure 8 and column 4, line 66 to column 5, line 10). The examiner takes Judicial Notice of the equivalence of joint fittings (such as dovetail joints etc) and adhesive (such as cement) as means of attaching surfaces together. Furthermore, Yamada specifically states that it is using these joint fittings instead of using cement for the purpose of attaching the surfaces (column 1, lines 12 to column 2, line 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the outer circumferential portions of the lenses of Yamada as being attached by adhesive instead of by use of joint fittings as disclosed since the examiner takes Judicial Notice of the equivalence of joint fittings and adhesive as means of attaching surfaces together and since Yamada teaches that it is using these joint fittings instead of using cement to attach the surfaces thereby making obvious the use of adhesive as a means of attaching the lenses together. In reference to claims 5 and 11, since these claims are broadly claiming "an intermediate member" than the use of an adhesive such as glue between the surfaces can be considered as "an intermediate member".

Allowable Subject Matter

The allowability of claims 3, 5 and 10-11 have been withdrawn based upon the rejections set forth above.

Claims 13-18 are allowed.

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Claims 6 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach the claimed combination of limitations. Specifically, with reference to claims 6 and 12, none of the prior art either alone or in combination disclose or teach of the claimed optical system having the claimed first and second optical lenses with the specific structure as claimed, the outer circumferences fixed in place or bonded as claimed, and specifically further with the second optical lens having the claimed two convex surfaces and the first optical lens serving as a convex lens i.e. as a positive lens. Specifically, with reference to claims 13-18 none of the prior art either alone or in combination disclose or teach of the claimed optical system having the claimed first and second optical lenses with the specific structure as claimed, the outer circumferences fixed in place relative to one another as claimed, and specifically further with the claimed optical lenses in an optical pickup comprising the claimed laser, optical system for focusing and photodetector.

Response to Arguments

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Though the applicant has amended the rejected claims, the examiner decided to make this action non-final, particularly in light of claim 10. Claim 10 was previously

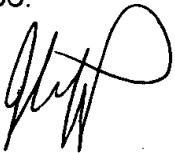
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indicated as allowable and applicant in effect has put claim 10 in independent form with the exception of clarifying a 112 rejection raised by the examiner. Therefore in fairness the examiner has made this office action non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Jordan M. Schwartz
Primary Examiner
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July 30, 2003